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EXAMINER

STERLING, AMY JO

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/712,281  
Filing Date: November 12, 2003  
Appellant(s): IBARA ET AL.

**MAILED**

JAN 18 2007

**GROUP 3600**

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Elisa Jones  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11/10/06 appealing from the Office action  
mailed 6/9/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is acceptable, in accordance with MPEP 1205.02. Applicant is *pro se*.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is acceptable, in accordance with MPEP 1205.02. Applicant is *pro se*.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

<b>6375165</b>	<b>Sherrat et al.</b>	<b>04-2002</b>
<b>5855329</b>	<b>Pagano</b>	<b>01-1999</b>
<b>5377946</b>	<b>Pannu</b>	<b>01-1995</b>
<b>4826099</b>	<b>Johnson</b>	<b>05-1989</b>
<b>3813075</b>	<b>Capper</b>	<b>05-1974</b>
<b>2004/0076825</b>	<b>Hashimoto et al.</b>	<b>04-2004</b>

Evaluation forms completed by participants in a commercial evaluation of the present invention on October 25, 2003, originally submitted with the Amendment faxed October 20, 2004.

Video. Please contact appellants should the Board desire a separate copy of this video.

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 4, 7, 10, 11, 13, 14, 16 and 21-24 are rejected under 35

U.S.C. 103(a) as being unpatentable over United States Patent No. 5377946 to Pannu and in view of United States Patent No. 6375165 to Sherratt et al.

Pannu discloses applicant's basic inventive concept including teaching a book holder applied directly to a book having a reading support (24) and a self-retracting reel that is a tensioning mechanism (Spring, with a certain K constant will set a

Art Unit: 3632

predetermined strength for the reel) set at a predetermined strength being sufficiently strong to retain pages in an open position yet sufficiently light to enable page turning, a plurality of gripping members (housing of 94 and 97) and a retaining line (92) of a predetermined length, the tensioning mechanism being attached to a gripping member and the line being attached to the tensioning mechanism so that the tensioning mechanism feeds and retracts additional line as the page is turned. (See Col. 4 lines 63-68 for operation).

Pannu also teaches the method of providing a page holder, providing a support for reading matter and placing reading matter on the support and attaching gripping members to opposed edges of the support and extending the line across the reading matter,

Pannu does not show a tension adjustment control on the reel so that the tension ranges can be between 0.05 N to 0.6 N or the method of using a tension adjustment control with that recited range.

Sherratt et al. shows a winding mechanism with a tension adjustment control (38, 68) and the method of using the control, the device used for adjusting the tension of the material wrapped around the reel (20) of the winding mechanism. Sherratt et al. does not disclose the specific tension range of .05N to .6N, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have this range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See In re Aller, 105 USPQ 233. Therefore, both limitations would

have been obvious to one having ordinary skill in the art at the time of the invention in order to adjust and control the tension of the line as taught by Sherratt et al. in order to control the tension of the line in Pannu and the method thereof.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5377946 to Pannu and in view of United States Patent No. 6375165 to Sherratt et al. as applied to claim 1 above, and in view of United States Patent No. 5855329 to Pagano.

Pannu and Sherratt et al. disclose applicant's basic inventive concept, all the elements which are shown above with the exception that they do not show that the gripping members are clamps.

Pagano teaches a book holder (10) with a book support and retention device (28), which has clamping gripping members (35) attached to the support, which are used in order to clamp the book cover in place, to further secure the book to the holder, used for retracting a line into the reel (22), the method being inherent from the structure. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Pagano to have used clamps as gripping members in order to further secure the book to the holder.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5377946 to Pannu and in view of United States Patent No. 6375165

to Sherratt et al. as applied to claims 1 and 3 above, and in view of United States Patent No. 4826099 to Johnson.

Pannu and Sherratt et al. disclose applicant's basic inventive concept, all the elements which are shown above with the exception that they do not show that the reel is biased by an elastic band nor the method wherein the reel is biased by an elastic band.

Johnson shows a self retracting reel (22) which is biased by an elastic band (26), used for retracting a line into the reel (22), the method being inherent from the structure. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Johnson to have used an elastic band to bias the reel, in order to retract the line into the reel.

Claims 8, 9, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5377946 to Pannu and in view of United States Patent No. 6375165 to Sherratt et al. as applied to claims 1 and 11 above, and in view of United States Patent Publication No. 2004/0076825 A1 to Hashimoto et al.

Pannu and Sherratt et al. discloses applicant's basic inventive concept, all the elements which are shown above with the exception that they do not show wherein the retaining line is a monofilament made from polyvinylidene fluoride or the method of providing the monofilament of polyvinylidene fluoride.

Hashimoto et al. discloses lines made of monofilaments that are polyvinylidene fluoride commonly termed PVDF, used for its resistance to deterioration in the

mechanical properties. The method is inherent from the structural teachings in Hashimoto et al. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Hashimoto et al. to have used this material and to have the method of using this material, in order to prevent deterioration of the mechanical properties of the line.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5377946 to Pannu and in view of United States Patent No. 6375165 to Sherratt et al. as applied to claim 1 above, and in view of United States Patent No. 3813075 to Capper.

Pannu and Sherratt et al. discloses applicant's basic inventive concept, all the elements which are shown above with the exception that they do not show that the device is a clipboard.

Capper shows a book holding device, that is a clipboard, (at 23) used to hold a book or loose pages in place. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Capper to have made the book holding device as a clipboard to hold a book or loose pages in place.

#### **(10) Response to Argument**

A. The combination of the Pannu and Sherratt et al. references have a valid motivation for combination.



In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, varying the tension of a winding reel that is used to retain items was well within the knowledge generally available to one of ordinary skill in the art at the time of the invention.

Pannu is a holder for books and pages (See Abstract, lines 4 and 18). It was well within the knowledge generally available that the tension line (92) would need to be adjustable in order to accommodate thicker books such as a dictionary and thinner pages such as sheet music. Therefore, according to *In re Fine*, the suggestion to combine has been established and the obviousness rejection is proper.

B. The combination of the Pannu and Sherratt et al. references are valid as analogous art

The examiner recognizes that in order to analyze the validity of an obviousness rejection, the combination of references, must be "analogous prior art".

The courts have described just what is meant by analogous art in saying that, "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992)

"A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) Even if not reasonably pertinent, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved.

Also, while Patent Office classification of references and the cross-references in the official search notes of the class definitions are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) (The

structural similarities and functional overlap between the structural gratings shown by one reference and the shoe scrapers of the type shown by another reference were readily apparent, and therefore the arts to which the reference patents belonged were reasonably pertinent to the art with which appellant's invention dealt (pedestrian floor gratings.); *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992)

In this particular case, the applicant argues that the Sherratt et al. reference is from a different field than the Pannu reference and is therefore nonanalogous art. This is unpersuasive because the Pannu device and the Sherratt et al. device are both reasonably pertinent to each other because they both deal with using biased reels to wind, the structure and function which are very similar. Since both references deal with winding, it would logically be within the inventor's attention to consider the problem of adjusting the tension of the winding devices. Therefore, according to current case law, the combination of the references meet the definition of being analogous art.

C. The secondary considerations are insufficient to overcome the rejection because the applicant has failed to meet the required burden of proof of unexpected results and commercial success.

The examiner must evaluate any objective evidence or secondary considerations such as unexpected results and commercial success. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983);

*Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987).

Furthermore, appellants have the burden of explaining the data in any declaration they proffer as evidence of non-obviousness." *Ex parte Ishizaka*, 24 USPQ2d 1621, 1624 (Bd. Pat. App. & Inter. 1992).

It is well settled that secondary considerations must be established by factual evidence. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965)

Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. *In re Chilowsky*, 306 F.2d 908, 134.

### 1. Unexpected Results

Any differences between the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is really unexpected. *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The evidence

relied upon should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992)

As shown by the case law cited above, in evaluating secondary consideration such as the alleged unexpected results, the applicant has the burden of proof for showing factual evidence that properties differ to such an extent that the difference is really unexpected.

The applicant has failed to provide such proof. The applicant alleges "unexpected results" stating that "pages can be safely turned without manipulation of the page holder" but fails to show evidence of which part or which feature provides the device with a vastly different result. The applicant also fails to provide any evidence that the turning of pages without manipulation is unexpected. There is no factual evidence of any kind, merely legal conclusions that the results are unexpected. Therefore, with the lack of any evidence, the applicant fails to prove that this secondary consideration is sufficient to overcome the obvious rejection.

## 2. Commercial Success

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. The term

"nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988).

The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating: In the *ex parte* process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sale constitute commercial success. *C.f. Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

The applicant fails to meet the burden of proof of commercial success. The applicant provides copies of "Consultation Response Forms" and asserts that there is "commercial potential". This is unpersuasive for several reasons. Without an actual sale of the product, the evidence presented does not rise to the level needed to assert that there is a nexus between the claimed invention and evidence of commercial success. An invention cannot be commercial successful before it is sold. The mere possibility of "potential" is speculative and therefore this secondary consideration is insufficient to invalidate the obvious rejection.

D. The obviousness rejections are proper because all of the claim limitations are met by the combinations

With regards to claim 2, the applicant has argued that the Pannu reference and the Pagano reference are nonanalogous to each other. This is clearly not the case since both references deal in the same endeavor of book holders.

Applicant has argued with regards to claims 3, 13, 14, 21 and 23, that the combination of the reference do not teach that a “reel is a self-retracting reel” or the method of having a self-retracting reel. This is unpersuasive in that the Pannu reference teaches a spring biased reel (94) which would retract the line by the spring bias, thereby meeting this limitation.

Applicants also argue that the reel is not set to a “predetermined strength”. This is unpersuasive in that the K constant of the spring chosen for the reel will determine the strength and can be calculated and chosen for a predetermined desired strength.

With regards to claim 7, the applicant's have argued that the tension range of 0.05 N to 0.6 N is not obvious because the range must be shown by the references. This is unpersuasive in that the range of tension is merely a design choice, the optimization of which would be obvious upon using the device. The tension range is a result of experimentation with the device using the conditions of using the device and not reciting significant structure that would delineate the present application from the cited prior art.

With regards to claim 10, the applicant argues that the limitation of having the function of being applied “directly to a book” is not met by Pannu. This is unpersuasive

in that the Pannu reference shows the book holder being applied directly to a book (See Figure 7).

With regards to claims 11 and 21 the applicant argues that the method of being "immediately turned under retention" is not shown by the references . This is unpersuasive in that the Pannu reference teaches that a bedridden person can read a book using the device (See Col.1, lines 63-64) and this would not be possible unless the books pages were able to be turned and read accordingly.

With regards to claim 16, the applicant argues that the references are individually complete and from different fields. The references being complete is not a legal standard for overcoming an obvious rejection. As discussed above, both references use a winding device, and therefore are not from different fields.


**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Amy J. Sterling  
1/8/06

  
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